

REMARKS

In view of the following remarks, Applicants respectfully request reconsideration and withdrawal of all grounds of rejection. Claims 1-50 are pending in the present application. Claims 2 and 19 have been amended to fix typographical errors. Claims 51-52 have been added. No new matter is introduced by way of this claim amendment and the new Claims 51-52 are fully supported by the specification. Acceptance is respectfully requested.

In the Office Action, Claims 1-36 were rejected under 35 U.S.C. 102(e) as being anticipated by Reich et al. (U.S. Pat. Appl. Pub. No. 2002/0059107) ("Reich").

According to MPEP § 706.02(b),

A rejection based on 35 U.S.C. 102(e) can be overcome by: ... (F) Perfecting benefit under 35 U.S.C. 119(a) or 120 ... by amending the specification of the application to contain a specific reference to a prior application ... and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph.

The present application already claims benefit under 35 U.S.C. § 119(a) to U.S. Provisional Application Ser. No. 60/289,975 entitled "Global Compliance System" ("Applicants' Provisional Application"), which was filed on May 10, 2001. Applicants' Provisional Application predates the June 8, 2001 filing date of Reich.

Applicants' Provisional Application also meets the enablement and written description requirements of 35 U.S. 112, first paragraph. To meet the written description requirement, "a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP § 2163(I). Claims 1-36 of the present application are directed to systems and methods for implementing a compliance program in a financial institution. Applicants' Provisional Application discloses the claimed compliance program system in sufficient detail that one skilled in the art could reasonably conclude that Applicants had possession of the inventions recited in the pending claims. *See, e.g.*, pp. 2, 4 and 9 and Figures 5-8 and 13-14. For example, the Applicants' Provisional Application describes the claimed list database as follows: "CUBS is a

Bank's static database containing a list of all public equities that has been traded by the Bank."

See p. 2.

To satisfy the enablement requirement, the specification must contain sufficient information regarding the claimed subject matter to enable one skilled in the art to make and use the claimed invention without undue or unreasonable experimentation. See MPEP § 2164.01. Applicants' Provisional Application contains 25 figures, most of which are detailed screenshots of a graphical user interface that show the operation of the claimed compliance program system. These 25 figures, along with the description of these figures in the specification of Applicants' Provisional Application, provide enough detail to enable a computer programmer of ordinary skill to design and implement a database and software code to carry out all the functions of the claimed compliance program system. Only a reasonable amount of experimentation would be necessary.

Since Applicants have shown that (1) the present application already claims the benefit of the filing date of Applicants' Provisional Application, which predates the 102(e) filing date of Reich, and (2) Applicants' Provisional Application satisfies the enablement and written description requirements of 35 U.S. 112, first paragraph, Applicants respectfully submit that the 102(e) rejection has been overcome.

New independent Claims 51 and 52 are directed to a system and method for implementing a compliance program for a financial institution. Applicants respectfully submit that these new independent claims are patentably distinguishable over Reich.

Claim 51 recites:

A system for implementing a compliance program in a financial institution, comprising:

a list database that stores material information regarding a plurality of entities that are known to the financial institution, the material information including a Grey List, a Restricted List, and restriction information related to the entities on the Grey List and the Restricted List; and

a list manager that receives a compliance query from an affiliate of the financial institution, the list manager configured to respond to the compliance query by retrieving and displaying the information stored in the list database that is responsive to the compliance query.

Claim 52 recites:

A method for implementing a compliance program in a financial institution, comprising:

storing a plurality of entities in a list database, the financial institution being associated with each of said plurality of entities;

partitioning the entities stored in the list database into a Restricted List and a Grey List;

storing restriction information related to the entities on the Restricted List and the Grey List;

receiving a compliance query from an affiliate of the financial institution; and

responding to the compliance query with restriction information stored in the list database that is responsive to the compliance query.

Reich teaches a fully automated transaction compliance system that, unlike the claimed system, uses a rules engine to determine whether a transaction is permitted. As shown in Figures 1 and 2 of Reich, an employee or other party submits an order for a securities transaction through a trading system 16. An order processing system 12 receives the order and forwards details about the transaction and the party making it to the automated compliance system 14. The automated compliance system 14 includes a rules engine 30 connected to a rules database 32, which contains predefined compliance rules. The rules engine 30 is also connected to a list server 34 through which the rules engine 30 can access trading restrictions from one or more control lists 36. The rules engine 30 evaluates the predefined compliance rules based on the

trading restrictions, the order information, and other pertinent information accessed from other databases to determine whether the transaction associated with the order is permitted.

Reich states that the fully automated system of Reich “reduces the duties of the [trade compliance officer] since the majority of potential transactions can be handled automatically with only a limited number requiring manual evaluation to consider issues not well suited for an automated system.” (Reich ¶ 17.) However, Reich does not disclose, teach, or suggest how a user of the system of Reich determines which potential transactions require manual evaluation.

Reich teaches away from the system of Claim 51 which uses a “list manager configured to respond to the compliance query by retrieving and displaying the information stored in the list database that is responsive to the compliance query.” It also teaches away from the method of Claim 52, which “respond[s] to the compliance query with restriction information stored in the list database that is responsive to the compliance query.” The inventions recited in Claims 51 and 52 provide responses to compliance requests by simply retrieving and displaying restriction information stored in the list database that is responsive to the compliance query. Thus, the claimed invention avoids the problem of determining which potential transactions require manual evaluation, while Reich does not provide a solution to this problem.

Because Reich fails to teach or suggest all the limitations of new Claims 51 and 52, Applicants respectfully submit that Claims 51 and 52 are patentably distinguishable from Reich (even if Reich qualified as prior art) and therefore should be allowed.

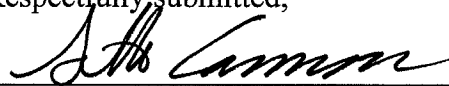
CONCLUSION

In view of all of the foregoing amendments and remarks, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of Claims 1-36 and 51-52.

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Respectfully submitted,



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